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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,932	05/24/2001	Tracey L. Glenn	310048-531	1692

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EXAMINER

SCHLAIFER, JONATHAN D

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 03/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/864,932	Applicant(s) GLENN ET AL.	
	Examiner Jonathan D. Schlaifer	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) 1-15 and 37-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/23/02, 12/08/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Application 09/864,932, filed on 05/24/2001. Prior art was filed on 9/23/2002 and 10/08/2004.
2. Claims 1-45 are pending in this case. Claims 16 and 23 are independent claims.

Election/Restrictions

3. Claims 1-15 and 37-45 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10/04/2004.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 30 recites the limitation "the passing" in line 2. There is insufficient antecedent basis for this limitation in the claim. The Examiner notes that this antecedent basis issue would be resolved if the claim were made to be dependent on claim 29 instead of claim 26, and this assumption has been made for purposes of examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 16-17, 19-21, 23-29, 31-32 and 34-36 are rejected under Braznell (USPN 3,762,630—filing date 5/20/1971), further in view of Corel, “Corel Custom Photo”, 1999, hereinafter Corel.**
6. **Regarding independent claim 16**, Braznell discloses a mailer system (see Abstract, lines 1-25), comprising a sheet having a plurality of weakened separation lines (see lines 7-10 of Abstract, reference to “seam perforations) thereon defining an outline of a combination postcard-card mailer separable therealong (given sufficient force, the seam could be used for separation) from the rest of the sheet after indicia has been applied to the mailer wherein at least one of the lines defines a line of separation between a postcard and a card of the combination mailer (see Abstract lines 5-15, the lines separate a postcard and a card). Braznell fails to disclose media containing program instructions allowing a user to design and print on a personal computer system the indicia on the mailer. However, Corel discloses on item 7 creating a card on a computer, and it was notoriously well known in the art at the time of the invention that computer output may be printed, so it would have been obvious to one of ordinary skill in the art at the time of the invention to create a card on a computer and to print it in order to facilitate creating the indicia.
7. **Regarding dependent claim 17**, Braznell fails to disclose that the media is a CD. However, Corel in item 1 discloses that the program is contained on a CD-ROM disc. It would have been obvious to one of ordinary skill in the art at the time of the invention to use a CD-ROM because that is how the program is distributed.

8. **Regarding dependent claim 19**, Braznell discloses that the card is a rectangular business card (the card is rectangular and could be used as a business card), and the separation lines define a disposable small sheet rectangle positioned at an end of and adjacent to the postcard and at an end of and adjacent to the business card, whereby the combination mailer and the small sheet rectangle together define a rectangle on the sheet (see Fig. 3 and Fig. 8).
9. **Regarding dependent claim 20**, Braznell discloses that the card is a rectangular business card (the card is rectangular and could be used as a business card).
10. **Regarding dependent claim 21**, Braznell and Corel fail to disclose that the card is a rotary card, but it was notoriously well known in the art at the time of the invention that cards may be rotary cards for use with rotary address books, and it would have been obvious to one of ordinary skill in the art at the time of the invention to use a rotary card to make the card compatible with rotary address books.
11. **Regarding independent claim 23**, it is a method which provides a sheet as in claim 16 and is rejected under similar rationale.
12. **Regarding dependent claim 24**, if the Corel software provided for in claim has been pre-installed on the user's system, it is existing software and hence the limitation of the claim is met.
13. **Regarding dependent claim 25**, if the Corel software provided for in claim has not been pre-installed on the user's system, it is new software and hence the limitation of the claim is met.

14. **Regarding dependent claim 26**, Braznell and Corel fail to disclose that the new software is supplied to the user in a retail package with the combination mailers. However, it was notoriously well known in the art at the time of the invention that related products may be sold in a retail package together for convenience in purchasing. It would have been obvious to one of ordinary skill in the art at the time of the invention to package the products together for convenience in purchasing.
15. **Regarding dependent claim 27**, Braznell and Corel fail to disclose after the separating, mailing the combination mailer to a recipient. However, it was notoriously well known in the art at the time of the invention that mailers are intended to be mailed. It would have been obvious to one of ordinary skill in the art at the time of the invention to mail the mailer because it would have transported in the information or goods contained therein.
16. **Regarding dependent claim 28**, Braznell and Corel fail to disclose the recipient separating the card from the postcard along the separation line. However, it was notoriously well known in the art at the time of the invention that parts of a mailer that are separated by a perforated line are designed to be separated along a separation line. It would have been obvious to one of ordinary skill in the art at the time of the invention to separate along the separation line in order to obtain distinct and separate parts of the mailer.
17. **Regarding dependent claim 29**, Braznell fails to disclose passing the sheet through a printer that prints the indicia on the mailer. However, Corel discloses on flap 4 printing projects to paper. It would have been obvious to one of ordinary skill in the art at the

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time of the invention to print the indicia to paper because it would have provided a permanent record.

18. **Regarding dependent claim 31**, Braznell fails to disclose custom designing on a personal computer system the indicia. However, Corel discloses on flap 7 custom designing projects. It would have been obvious to one of ordinary skill in the art at the time of the invention to custom design the projects because it would have provided a permanent record.
19. **Regarding dependent claim 32**, Braznell discloses that the indicia includes indicia on the postcard and indicia on the card (see Fig. 11).
20. **Regarding dependent claim 34**, it is analogous to claim 20 and is rejected under similar rationale.
21. **Regarding dependent claim 35**, it is analogous to claim 21 and is rejected under similar rationale.
22. **Regarding dependent claim 36**, Braznell discloses applying a stamp (it is item 56, Fig. 4).
23. **Claims 18 and 33 are rejected under Braznell, further in view of Corel, further in view of Catapult, Inc. "Microsoft Word 97: Step by Step", 1997, hereinafter Catapult, Inc.**
24. **Regarding dependent claim 18**, Braznell and Corel fail to disclose that the indicia is printed on the postcard in a portrait direction of the sheet and the indicia is printed on the card in a landscape direction of the sheet. However, the graphics on pages 105-106 of Catapult, Inc. show that portrait/landscape orientation is an arbitrary, freely choosable

design choice and hence it would have been obvious to one of ordinary skill in the art at the time of the invention to print on the postcard in portrait and in the card in landscape because it would have fit the content better onto the regions of the mailer.

25. **Regarding dependent claim 33**, it applies the limitations of claim 18 to claim 23 and it is rejected under similar rationale.
26. **Claims 22 and 30 are rejected under Braznell, further in view of Corel, further in view of Shaad (USPN 3,580,490—filing date 2/20/1970).**
27. **Regarding dependent claim 22**, Braznell and Corel fail to disclose that the sheet includes a calendered printer-infeed end edge. However, in col. 2, lines 45-65, Shaad discloses the use of a calendered edge. It would have been obvious to one of ordinary skill in the art at the time of the invention to use a calendered edge in order to facilitate the printing process.
28. **Regarding dependent claim 30**, the calendered edge may be rejected as in claim 22, and the rest of the claim may be rejected because it would have been obvious to one of ordinary skill in the art at the time of the invention to feed the calendered infeed edge into the printer first.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

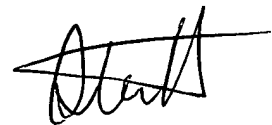
USPN 5,076,490 (filing date 8/20/1990)—Dulin

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan D. Schlaifer whose telephone number is (571) 272-4129. The examiner can normally be reached on 8:30-5:00, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JS



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